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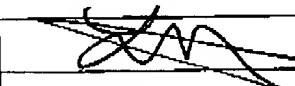
Total Number of Pages in This Submission **15**

Application Number	09/730,219
Filing Date	December 5, 2000
First Named Inventor	Chidlac, et al.
Art Unit	2162
Examiner Name	Shahid Al Alam
Attorney Docket Number	YOR9200000746US1

ENCLOSURES (Check all that apply)

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- [ ] After Allowance Communication to TC
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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☑002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Chidiac, et al.

Serial No.: 09/730,219   Group Art Unit: 2162

Filed: December 5, 2000   Examiner: Shahid Al Alam

For: **METHOD, SYSTEM AN PROGRAM
PRODUCT FOR DETERMINING A FILE
FORMAT FOR USE IN A TRANSLATION
OPERATION**

                                                                March 1, 2007

SUBSTITUTE APPEAL BRIEF

Commissioner of Patent
       and Trademarks
Alexandria, VA 22314

In reply to the Notification of Non-Compliant Appeal Brief mailed February 1, 2007, applicants submits this substitute appeal brief to further identify disclosure in the specification to support the claim features.

Pursuant to 37 CFR §41.1 et seq., applicants reiterate the arguments made in reply to the examiner's rejections during the course of prosecution and hereby submit this appeal brief in response to the final rejection mailed April 6, 2006.

I.   **Real Party in Interest**

The real part in interest is International Business Machines, Inc.

II.   **Related Appeals and Interferences**

Applicants are not presently aware of any prior or pending appeal, interference, or judicial proceeding related to, or that directly affects or is directly affected by or has a bearing on the Board's decision in this appeal.

III. Status of Claims

All claims stand rejected. Thus, applicants appeal the rejection of claims 1-23 of the present application.

IV. Status of Amendments

No amendment was filed after final rejection of April 6, 2006.

V. Summary of Claimed Subject Matter

Without limiting the invention, the subject matter of the invention generally concerns translating data files stored in various legacy formats to a more usable desired format requested by a user. When a legacy file exists in several formats, an *optimal* one of such multiple file formats is selected for translation, and the selected format is used to derive a corresponding file in a desired format. *Optimizing* the selection may be based on minimizing data loss, file size constraints, file type, predetermined priority, known conversion algorithms, or any other criterion to facilitate converting the legacy file to a desired file format. Figs. 7-8 and specification pages 20-23 summarizes the relevant subject matter on appeal.

Claim 1

Independent claim 1 recites a method of selecting an *optimal* format of a file from a plurality of stored formats of said file. The selected *optimal* format is then used in performing a translation to a requested file format. Step-by-step, claim 1 recites:

Receiving a Request

A first step of the method includes receiving a request for a data file in a requested format (i.e., DFORM (data format) and DTYPE (data type) fields are parsed to ascertain the requested format). See, p. 20, lines 8-12 and Fig. 7, Step 701 of applicants' specification.

Determining an Optimal File Format

A second step includes determining an *optimal* file format from a plurality of stored file formats as a starting point to begin performing the translation to the requested file format. See, Fig. 7, Steps 702-706 (parsing the request 702, detecting a need for translation 703,

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detecting multiple available formats 704, and accessing a table to detect an optimal one of the available formats for translation 705-706). See also, p. 20, line 12, through p. 21, line 2.

Fig. 8 shows an example of determining an *optimal* format to perform a translation. Therein is also shown a list of possibly requested file formats (column 801) and, for each possibly requested formats in column 801, an order of precedence of starting file formats (column 802) from which to perform the translation to produce a file in one of the possibly requested formats listed in column 801. See also, p. 21, lines 3-21. Priority of selection may be based on a Preference Number 1, 2, ... associated with entries in column 802.

Translating the Optimal File Format

After determining the *optimal* format from which to start the translation, a third step includes translating (Fig. 7, Step 707) the thus determined *optimal* file format of the legacy data file to derive a corresponding file in a requested file format. This is described at p. 21, lines 22-23 of applicants' specification.

Providing the Requested File Format to a User

The final step of claim 1 is providing the requested file format to a user, which is described at page 19, lines 8-10. See also, Fig. 1, user 106 and; fig 4, step 413

Thus, the invention of claim 1 comprises receiving a request for a data file in a requested format, determining an *optimal* format from which to translate the file to the requested format if is not stored in such format, and then translating the *optimal* format of such file in order to derive the requested file format.

Claim 2

Dependent claim 2 includes *prioritizing* the order of preference for choosing the *optimal* starting format based on minimizing data loss during the translation. For example, see Fig. 8, Preference Number Column 802 that shows sequencing according to extent of data loss. This is further described at p. 21, lines 3-6 of the specification.

Claim 3

Dependent claim 3 specifies file size as a criterion for *prioritizing* the order of preference, which is described at p. 21, lines 7-10 of the specification.

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Claim 4

Dependent claim 4 specifies utilizing a relationship between the requested and available file formats, which is described at p. 21, lines 10-17 of the specification.

Claim 5

Dependent claim 5 specifies consulting an *optimized list* as a basis to determine which format to use as a starting translation to the requested file format, which is also shown in Fig. 8 and disclosed at p. 21, lines 3-6, of the specification.

Claim 6/5

Claim 6 recites indexing by the requested file format, which is described at p. 20, lines 3-7, 19-22; p. 21, lines 3-17. See, also, preference numbers between columns 801, 802 (Fig. 8).

Claim 9/8

Claim 9 recites ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file, which is described at p. 20, lines 3-7, 19-22; p. 21, lines 3-17. See, also, preference numbers between columns 801, 802 (Fig. 8).

Claim 12

Independent claim 12 recites a program storage device embodying computer-readable program instructions to effect implementation of the aforementioned methods in a computer. In particular, claim 12 recites a program storage device (data respository 102, Fig. 1; p. 10, lines 5-8) readable by a digital processing apparatus (p. 10, lines 8-10) and tangibly embodying a program of instructions executable by the digital processing apparatus to perform method steps for selecting (p. 15, lines 4-8; p. 19, lines 2-8) a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested file format (p. 15, lines 9-11; p. 17, lines 21-23); and

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determining an optimal file format from a plurality of stored file formats of said data file for use in performing said translation to said requested file format (p. 20, lines 3-7; p. 20, lines 8-18 (Fig. 7)).

The method implemented by the program instructions are shown in Figs. 7-8, as further described at pp. 20-23 of applicants' specification.

Claim 13

Dependent claim 13 recites minimizing data loss during the translation. For example, see Fig. 8, Preference Number Column 802 that shows sequencing according to extent of data loss. This is further described at p. 21, lines 3-6 of the specification.

Claim 14

Dependent claim 14 recites minimizing file size as a criterion for *prioritizing* the order of preference, which is described at p. 21, lines 7-10 of the specification.

Claim 15

Dependent claim 15 recites utilizing a relationship between the requested and available file formats, which is described at p. 21, lines 10-17 of the specification.

Claim 16

Dependent claim 16 recites consulting an *optimized list* as a basis to determine which format to use as a starting translation to the requested file format, which is also shown in Fig. 8 and disclosed at p. 21, lines 3-6, of the specification.

Claim 23

Independent apparatus claim 23 recites an apparatus to obtain a desired file format by translating an *optimal* one of a group of possible file formats. The apparatus comprises an interface (301A, Fig. 3) to receive a request and translation logic (304, Fig. 3) to determine the optimal starting format from which to perform the translation to a requested format as well as control logic to implement the translation. In particular, claim 23 recites an apparatus for selecting (p. 15, lines 4-8; p. 19, lines 2-8) a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, said apparatus comprising:

an interface element (301, 302) Fig. 3; p. 16, lines 19-22) for receiving a request for a data file in a requested file format; and

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translation optimization logic (Fig. 7; 611, 601, 603 (Fig. 6)) coupled to said interface (301, Fig. 6) for determining an optimal one of a plurality of file formats for use in performing said translation to said requested file format (p. 20, lines 3-7; p. 20, lines 8-18 (Fig. 7)).

VI. Grounds of Rejection To Be Reviewed on Appeal

Applicants request the Board to review the following ground of rejection asserted by the examiner:

A. The rejection under 35 USC §103(a) of claims 1-23 as being unpatentable over U.S. Patent 5,608,874 to Ogawa et al. (Ogawa '874) in view of applicants' admitted prior art.

It is applicants' position that the examiner improperly interprets applicants' disclosure (i.e., the passages relied on by the examiner are not, in fact, "admitter prior art") and that Ogawa '874 does not show what the examiner contends it shows, particularly with regard to the limitations pertaining to "determining an optimal starting format" from which to translate a requested file a desired format.

VII. Argument

A. Admitted Prior Art Not Substantiated

This appeal involves relatively straight-forward questions: Does Ogawa '874 show all claim limitations of claims 1 and 11 except "selecting an optimal format from which to perform a translation? Has applicant admitted the presence of the missing limitation in the prior art?

The examiner concedes that Ogawa '874 fails to disclose determining an *optimal* file format from which to begin a translation to a requested file format. But according to the examiner, Ogawa's deficiency with respect to the rejection of claims 1 and 11 is met by the applicants' admission contained at page 3, second paragraph, of the specification. The passage relied upon, in entirety, provides:

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> **Since it may often be the case that a requested data file exists within an enterprise in many different formats other than the requested format, a further advantageous aspect of the transcoding scheme would provide logic for selecting the *optimal version* of a requested data file from which to perform the translation. [italics added]**

This, the examiner deems to be an inherent admission that "determining or selecting an *optimal* one of plural file formats from which to begin a translation" is old. The examiner says that the admitted prior art "discloses a requested data file exists ... in many different formats other than the requested format, ... for selecting the *optimal version* of a requested data file from which to perform the translation."

In exalting form over substance, the examiner contends that "any" material found in the "Background" section of a patent application can be relied on as admitted prior art. At pp. 2-3 of the final rejection, the examiner alludes to the "arrangement of specification" under MPEP §608.01(a) as it relates to the preferred information that should be contained in the (1) Field of Invention and (2) Description of Related Art. Relying simply on the preferred (but not mandatory) form of the application, the examiner then takes the quoted passage out of context to construct an argument of admitted prior art. We believe this was error.

While the passage relied upon provides that the *transcoding scheme* provides for selecting an *optimal file format* from which to begin a translation, the immediately preceding sentence states this to be the problem solved or objective achieved by the present invention, to wit: "there is a need to provide a seamless data format ... *transcoding scheme* to further improve inter-enterprise data exchange." Thus, the "transcoding scheme" referred to in applicants' specification (which provides for selecting an optimal version) is not an "admission" but clearly refers back to the "transcoding scheme" of the preceding sentence. In short, the quoted passage does not characterize a pre-existing prior art system or scheme. There simply is no admitted prior art as the examiner erroneously concluded.

Similarly, the examiner erroneously rejected claims 2-3 and 7-8 because, in his view, the "prior art" status of additionally claimed features (i.e., selecting an optimum translating file format based on minimizing data loss or file size) was admitted at p. 3, second paragraph, of

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applicants' disclosure. The quoted passage relied upon by the examiner, however, has nothing to do with minimizing data loss or file size. Thus, the rejection of these claims also should not be sustained.

B. Rejection Under 35 USC §103(a)

Claim 5 reads, as follows:

> 5. The method according to claim 1 wherein said determining step
> further includes the step of consulting an *optimized list of file
> formats* from which to perform said translation of said stored data
> file to the requested file format. (emphasis added)

In his technical analysis regarding the rejection of claim 5, we believe the examiner mistakenly reads the "optimized list" limitation on the "Subscriber Translation Information" of Ogawa '874. In claim 5, the starting format from which to perform the translation to the requested format is *determined* based on consulting an *optimized* list of file formats. In his rejection, the examiner refers to Ogawa '874's "Subscriber Translation Information 312" from Subscriber Table 314 discussed at col. 16, lines 18-23. It is applicant's' position, however, that the information contained in 312 is totally devoid of any "optimized list," e.g., an ordered list, to be used in determining a priority of translating a target file to a requested file format. It is not seen and we believe the examiner has not adequately explained how Subscriber Translation Information 312 is equivalent to an optimized list, as claimed.

Claim 6 provides:

> 6. The method according to claim 5 wherein said list is *indexed* by
> said requested file format. (emphasis added)

In rejecting claim 6, the examiner states that Ogawa '874, col. 34, lines 50-64, shows "indexing" by the requested file format. However, a careful review of the quoted passage fails to show "indexing," as claimed.

Claim 9 provides:

> 9. The method according to claim 8 wherein *ordering* of said
> optimized lists is based on criterion regarding the translation to
> be performed on the stored data file.

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In rejection claim 9, the examiner contends that "ordering" the optimized list based on criterion regarding the translation is shown at Ogawa, col. 2, line 59 to col. 3, line 4. No such "ordering," however, is shown in the quoted passage.

For similar reasons, the examiner's summary rejection of claims 12-23 according to the rejection of claims 1-11 is also faulty.

Limitations of independent claim 23, for example, include "optimization logic ... for determining an *optimal* one of a plurality of file formats for use in performing said translation to said requested file format." While Ogawa '874 might be construed to disclose formats of "Provider Data File Transactions" (see, Ogawa, col. 16, lines 18-22), the reference still falls short of teaching or suggesting determining an *optimal* one of a plurality of formats from which to begin a translation. Since Ogawa '874 uses a standard, intermediate, common format for a first conversion of a legacy file (in order to enable uniform secondary translation scheme to obtain a requested file format), Ogawa has no need choose any particular starting format (or any optimal format) to begin a translation,. Nothing in Ogawa '874 is said about determining an *optimal* one of multiple formats to begin a translation. The examiner simply gives Ogawa '874 more weight than due. Thus, for these and other reasons, the rejection should not be sustained.

C. Conclusion

Regarding admitted prior art, the examiner simply misreads or misinterprets applicant's disclosure. Regarding Ogawa '874, the examiner ascribes more substance than is actually contained in the reference.

Accordingly, applicant requests the Board review of the propriety of the examiner's rejections.

VIII. Claims Appendix

Claims on appeal, as amended on January 23, 2006 and finally rejected on April 6, 2006, appear in the attached claims appendix.

IX. Evidence Appendix

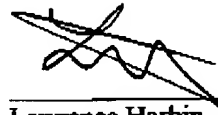No extraneous evidence is submitted at this time.

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X.   **Related Proceedings Appendix**

There are no known proceedings related to this appeal.

A claims appendix follows this page.

An appeal fee of $500 was submitted with the initial brief dated 9/6/2006.

Respectfully submitted,
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Claims Appendix

1. A computer-implemented method for selecting a file format from a plurality of stored file formats for use in performing a translation from a selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested format;

determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation to said requested file format;

translating the optimal file format of said data file determined in said determining step to the requested file format, and

providing the requested file format to a user.

2. The method according to claim 1 wherein said determining step is based upon minimizing data loss from said translation.

3. The method according to claim 1 wherein said determining step is based upon minimizing the file size of the translated data file.

4. The method according to claim 1 wherein said determining step is based upon the requested file format and available stored file formats.

5. The method according to claim 1 wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format.

6. The method according to claim 5 wherein said list is indexed by said requested file format.

7. The method according to claim 5 wherein said optimized list is consulted if the data file is stored in a plurality of formats.

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8. The method according to claim 5 wherein said consulting step further includes selecting one of said optimized list from a plurality of said optimized lists.

9. The method according to claim 8 wherein ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file.

10. The method according to claim 9 wherein said criterion is defined by a received request for said data file.

11. The method according to claim 6 further comprising the steps of:

accessing a portion of said optimized list ordered based upon the requested file format;

determining whether one or more of said listed file formats exists as one of said stored file formats; and

selecting from said optimized list the optimal file format that is determined to exist as a stored file format.

12. A program storage device readable by a digital processing apparatus and tangibly embodying a program of instructions executable by the digital processing apparatus to perform method steps for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested file format; and

determining an optimal file format from a plurality of stored file formats of said data file for use in performing said translation to said requested file format.

13. The program storage device according to claim 12 wherein said determining step is based upon minimizing data loss from said translation.

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14. The program storage device according to claim 12 wherein said determining step is based upon minimizing the file size of translation of said data file.

15. The program storage device according to claim 12 wherein said determining step is based upon the requested file format and the available stored file formats.

16. The program storage device according to claim 12 wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format.

17. The program storage device according to claim 16 wherein said list is indexed by said requested file format.

18. The program storage device according to claim 16 wherein said optimized list is consulted if the stored data file is stored in a plurality of formats.

19. The program storage device according to claim 16 wherein the consulting step further includes selecting one or said optimized lists from a plurality of said optimized lists.

20. The program storage device according to claim 19 wherein the ordering of said optimized lists is based on criterion regarding the translation to be performed on the data file.

21. The program storage device according to claim 20 wherein said criterion is defined by a received request for said data file.

22. The program storage device according to claim 17 further comprising the steps of:
        accessing a portion of said optimized list ordered based upon the requested file format;
        determining whether one or more of said listed file formats exists as one of said stored file formats; and

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selecting from said optimized list the optimal file format that is determined to exists as a stored file format.

23. An apparatus for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, said apparatus comprising:

an interface element for receiving a request for a data file in a requested file format; and

translation optimization logic coupled to said interface for determining an optimal one of a plurality of file formats for use in performing said translation to said requested file format.

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